REMARKS

The above amendments and following remarks are submitted under 37 C.F.R. 1.116 in response to the Final Official Action of the Examiner mailed February 10, 2005. Having addressed all objections and grounds of rejection, claims 1-25 as amended, being all pending claims, are now deemed in condition for allowance. Entry of these amendments and reconsideration to that end is respectfully requested.

Claims 11-15 have been rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,544,327, issued to Dan et al (hereinafter referred to as "Dan"). This ground of rejection is respectfully traversed as to the amended claims for the following reasons.

The architecture of Applicants' invention as disclosed and claimed is substantially different from the architecture described by Dan. In Applicants' system, a user makes a video-on-demand request to a "receiving means" (i.e., "multi-media application server" as disclosed in the preferred embodiment), which in term spools the requested program from long term storage into the claimed "storing means" (i.e., temporary memory) and assigns one of a "plurality of streaming means" (i.e., video servers) for "streaming" the requested video to the user. The "multi-media application server" improves overall efficiency of the system through the manner in which it handles the user

request, prepares (i.e., "spools") the requested program for delivery, and selects one of a number of video servers for streaming the program to the user. Though the Examiner may find examples of some of these various structures and functions within the prior art, it is the specific architecture disclosed and claimed by Applicants which provides the many advantages of Applicants' invention. For example, the process of recording and billing are much enhanced by routing all user requests directly to the centralized "multi-media application server". Similarly, such central control promotes efficiency of operation, adds convenient modularity for system expansion, and lowers overall cost.

Claims 11-15 are apparatus claims having "means-plus-function" limitations. As a matter of law, for example, the claimed plurality of "streaming means" are the plurality of video servers disclosed by Applicants and equivalents thereof. Dan has but one video server (i.e., video server 30). In accordance with MPEP 2181 et seq., the Examiner is not permitted to equate disks 55 of Dan with the claimed "streaming means" in view of Applicants' disclosure. Similar issues arise with the examination of the remaining claim elements of claims 11-15.

In the Dan approach, a single video server (i.e., video server 30) is employed to perform all of the claimed functions. As a result, all four claimed elements (i.e., "storing means",

"receiving means", "plurality of streaming means", and "determining means") are all read by the Examiner onto a single element (i.e., video server 30 of Dan). This examination approach is improper as a matter of law and completely inconsistent with the requirements of MPEP 2181 et seq. Furthermore, the teaching of Dan to utilize a single piece of hardware (i.e., video server 30) to read on all four discrete elements of the claims, ensures that Dan cannot anticipate the claims.

Because the Examiner apparently has had some difficulty in appreciating the architectural significance of Applicants' invention, slight amendments have been made to claim 16 to more explicitly highlight Applicants' architecture.

Specifically, claim 11, as amended, requires that the "receiving means" spool the requested program from long term storage into the "storing means" and that the "streaming means" stream the requested program from the "storing means" to the user. This cannot happen in the system of Dan because the Examiner finds: 1)buffer pool 40 (located within video server 30) of Dan is the claimed "storing means"; 2)video server 30 of Dan is the claimed "receiving means"; 3)disks 55 of Dan stream the video into buffer pool 40 (located within video server 30) of Dan as the claimed "streaming means"; and 4)communication process 60 (located within video server 30) of Dan is the claimed

12

"determining means". In other words, the alleged "receiving means" of Dan does not spool video from long term storage into the "storing means" and the "streaming means" of Dan does not stream video from the "storing means" to the user. As a result, Dan does not comply with MPEP 2131, and anticipation cannot be shown.

The rejection of claim 11, and all claims depending therefrom, is respectfully traversed.

Claim 12 depends from claim 11 and further limits the claimed "directing means". The Examiner has found that communication process 60 of Dan corresponds to the claimed "directing means". In making his rejection, the Examiner cites column 3, lines 46-50, and column 4, lines 46-50, of Dan. These citations say nothing of the operation of communication process 60 of Dan, which the Examiner has found to be the "directing means". As a result, the rejection of claim 12 is respectfully traversed because the Examiner does not address the claim (i.e., further limitations of the "directing means").

Claim 13 depends from claim 11 and further limits the claimed "determining means". In rejecting claim 11, the Examiner has found that communication process 60 of Dan corresponds to the claimed "determining means". In rejecting claim 13, the Examiner does not address the claimed "determining means" or communication process 60 of Dan. As a result, the examination of claim 13 is

inadequate as a matter of law. Furthermore, claim 13 requires

selection based upon "sufficient free storage". Dan says nothing

of this factor. The rejection of claim 13 is respectfully

traversed.

Claim 14 depends from claim 11 and is further limited by an

"identifying means". The Examiner's rejection does not address

Applicants' claimed invention and is not coherent. Therefore,

the rejection of claim 14 is respectfully traversed.

Claim 15 depends from claim 14 and further limits the

"determining means". These further limitations are associated

with the claimed "capacity" of the claimed "streaming means".

Dan says nothing of the capacity of disks 55 (which the Examiner

has found to correspond to the "streaming means") to stream video

to users. The rejection of claim 15 is respectfully traversed.

Claims 1-10 and 16-25 have been rejected under 35 U.S.C.

103(a) as being unpatentable over Dan in view of U.S. Patent

5,675,736, issued to Suzuki et al (hereinafter referred to as

"Suzuki"). This ground of rejection as to the amended claims is

respectfully traversed for failure of the Examiner to present a

prima facie case of obviousness.

To present a *prima facie* case of obviousness, the Examiner

is required by MPEP 2143 to make the following three showings:

1)motivation to make the alleged combination; 2)reasonable

likelihood of success of the alleged combination; and 3)all

claimed elements within the alleged combination.

In paragraph 3 of the present official action, the Examiner finds:

> Regarding claim 11, Dan discloses........plurality of means for streaming means responsively coupled to said storing means for streaming said video program (a plurality of video streams stored in a number of disks 55 coupled to the buffer pool 40)....

In paragraph 5 of the present official action, the Examiner states:

> Regarding claim 1, Dan discloses....a plurality of disks 55 supplying video data to said user....

Also within paragraph 5, the Examiner inconsistently states:

> Dan does not disclose a plurality of video servers for supplying video data.

As a result, it is not clear what the Examiner has found with regard to the teaching of Dan.

Nevertheless, in an apparent attempt at showing motivation for the alleged combination, the Examiner states:

> Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Dan by including a plurality of video information server (sic) 14 for supplying video information as taught by Suzuki <u>in order to provide different types of video information to the users</u>. (Emphasis added)

This is precisely the unsupported conclusion attacked by the Court of Appeals for the Federal Circuit stating in part:

> Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence". *In re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q. 2d 1614 (Fed. Cir. 1999.

The statement is conclusory because there is no showing that the alleged combination can supply types of video information not supplied by Dan. Therefore, the Examiner has failed to show motivation of the alleged combination as required by MPEP 2143.

The Examiner does not even address his obligation to show "reasonable likelihood of success". As a matter of fact, there would not be any practical way to make the alleged combination, because the video information server apparatus 14 of Suzuki are the only handlers of video data within the system. Suzuki has no storage, spooling, streaming, or other video functions except within video information server apparatus 14. The Examiner could not show likelihood of success in accordance with MPEP 2143, even if he were to attempt to do so.

In addition, the Examiner clearly fails to show all of the claimed limitations. With regard to claim 1, for example, the alleged combination does not have "a plurality of video servers each including a separate hardware and software subsystem" as claimed. Similarly, the alleged combination does not have "a multimedia application server including a dedicated hardware and software subsystem responsively coupled to said temporary memory which receives said request from said user, spools said video data into said temporary memory, and selects a particular one of said plurality of video servers to stream said video data from said temporary memory to said user in response to said user

16

request". The alleged combination simply cannot spool data into the temporary memory using a first hardware/software subsystem and stream the data from the temporary memory to the user using a second hardware/software subsystem.

Thus, the rejection of claim 1, and all claims depending therefrom, is respectfully traversed for failure of the Examiner to make any of the three required showings to present a *prima facie* case of obviousness.

The same issues are present with the rejection of independent claims 6, 16, and 21. In each case, the amended claims require spooling of video data into a temporary memory by a first hardware/software subsystem and streaming of the video data from the temporary memory to a user by a second hardware/software system. As explained above in detail, neither Dan nor Suzuki nor the combination thereof can operate in accordance with this claimed approach. The rejections of claims 6, 16, and 21, and all claims depending therefrom, are respectfully traversed.

Claims 2, 7, 17, and 22 depend from claims 1, 6, 16, and 21, respectively, and further limit the selection process of the claimed "multimedia application server". The alleged combination of Dan and Suzuki does not have a "multimedia application server" which makes the claimed selection. The alleged combination cannot make these further limitations. Therefore, the rejection

of claims 2, 7, 17, and 22 is respectfully traversed.

Claims 3, 8, and 23 depend from claims 1, 6, and 21, respectively, and further limit the selection process of the claimed "multimedia application server". The alleged combination of Dan and Suzuki does not have a "multimedia application server" which makes the claimed selection. This fact is specifically supported by the Examiner's rejection which states:

> Particularly, Dan discloses that the buffer manager makes a list of disks......

Thus, even though the Examiner has found that communication process 60 makes the selection, he now ascribes the further limitations of these dependent claims to buffer manager 80. The alleged combination cannot make these further limitations. Therefore, the rejection of claims 3, 8, and 23 is respectfully traversed.

Claims 4, 9, 18, and 24 depend from claims 1, 6, 16, and 21, respectively, and further limit the selection process of the claimed "multimedia application server". The alleged combination of Dan and Suzuki does not have a "multimedia application server" which makes the claimed selection. The alleged combination cannot make these further limitations. Therefore, the rejection of claims 4, 9, 18, and 24 is respectfully traversed.

Claims 5, 10, 19, and 25 depend from claims 1, 6, 16, and 21, respectively, and further limits the process of the claimed "multimedia application server" in replacing a previous video

18

program within the temporary memory. The alleged combination of Dan and Suzuki does not have a "multimedia application server" which makes the claimed selection. The alleged combination cannot make these further limitations. Perhaps recognizing this problem, the Examiner apparently finds the claimed functionality "inherent" in buffer manager 80 without explicitly saying so. Furthermore, because the Examiner has not met his burden under MPEP 2112 for showing inherency, the rejection is inadequate as a matter of law. Therefore, the rejection of claims 5, 10, 19, and 25 is respectfully traversed.
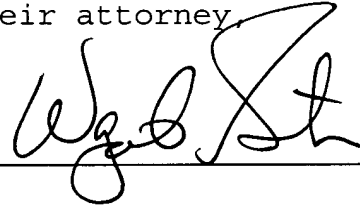
Claim 20 depends from claim 16 and further limits the determining step with "inhibiting said unloading of said previously loaded video program if the performance utilization of said previously loaded program is greater than the performance utilization of said video program". This requires a specific algorithm not found in the alleged combination. Therefore, the Examiner ignores the actual claim limitations. The rejection of claim 20 is respectfully traversed as being inadequately examined as a matter of law.

Having thus responded to each objection and ground of rejection, Applicants respectfully request entry of this amendment and allowance of claims 1-25, being the only pending claims.

Please charge any deficiencies or credit any overpayment to Deposit Account No. 14-0620.

Respectfully submitted,

Michael J. Rieschl et al.

By their attorney,

Date April 11, 2005

Wayne A. Sivertson
Reg. No. 25,645
Suite 401
      Broadway Place East
3433 Broadway Street N.E.
Minneapolis, Minnesota
      55413
(612) 331-1464